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OFFICE OF PETITIONS

In re Application of :
Alvarenga Baptista et al. :
Application No. 10/689,662 : DECISION ON PETITION
Filed: October 22, 2003 :
Attorney Docket No. 2764-127 :
:

This is a decision on the "PETITION UNDER 37 CFR § 1.182 TO ACCORD A FILING DATE OF OCTOBER 22, 2003," filed April 1, 2004. Applicants request that the above-identified nonprovisional application be accorded a filing date of October 22, 2003 with figure 1 submitted on petition added to the application.

Application papers in the above-identified application were deposited on October 22, 2003. However, on January 23, 2004, the Initial Patent Examination Division mailed applicants a "Notice of Incomplete Nonprovisional Application," stating that the application papers deposited October 22, 2003 had not been accorded a filing date because the application was deposited without drawings.

In response, applicants filed the instant petition. Applicants state that this application should be accorded a filing date as of the date of original deposit because:

the omitted drawing figure was a schematic illustration of a conventional structure provided solely for explanatory purposes and that the original disclosure was complete and enabling to one skilled in the art in the absence of that drawing illustration.

Moreover, applicants point out that the invention disclosed in the application relates to a process. However, applicants also request that the application be amended to include this drawing figure that schematically illustrates a state of the art structure. Applicants state that this drawing does not constitute new matter to this application.

RELEVANT STATUTES AND REGULATIONS

35 U.S.C. 111(a)(4) provides that:

The filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

However, as stated in MPEP 601.01(f)

It has been USPTO practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence).

In regards to withdrawing the Notice, MPEP § 601.01(f) also states that:

a nonprovisional application having at least one claim ..., directed to subject matter discussed above for which a drawing is usually not considered essential for a filing date, describing drawing figure(s) in the specification, but filed without drawings will be treated as an application without all of the drawing figures referred to in the specification as discussed in MPEP § 601.01(g), so long as the application contains something that can be construed as a written description.

And, MPEP § 601.01(g) further provides that:

If the application is filed without all of the drawing figure(s) referred to in the specification, ..., OIPE will mail a "Notice of Omitted Item(s)" indicating that the application papers so deposited have been accorded a filing date, but are lacking some of the figures of the drawings described in the specification.

DISCUSSION

A review of the application confirms that as filed it contained at least one process claim. Pursuant to § 601.01(f), a drawing is not considered essential for a filing date. Thus, the application is entitled to a filing date without drawings present in the application.

However, as the specification in the instant nonprovisional application contained reference to drawing figure 1 (Brief Description of Drawings, p. 13 of Specification), mailing of a Notice requiring submission of that drawing was appropriate. The Office should have mailed a "Notice of Omitted Items" rather than a "Notice of Incomplete Nonprovisional Application." The "Notice of Incomplete Nonprovisional Application" mailed January 23, 2004, was mailed in error and is hereby withdrawn.

Nonetheless, applicant's reference to drawings in the specification would have warranted the Office mailing applicant a "Notice of Omitted Items." Thus, it would still have been necessary for applicant to file a petition under § 1.53(e)(2). Accordingly, the petition fee is required and will not be refunded.

In view thereof, the application as originally deposited without drawings is entitled to a filing date of October 22, 2003.

Consideration now turns to petitioner's request to amend the application to include Figure 1. Petitioner acknowledges that Figure 1 was not present in the application on filing. A figure not present in the application on the filing date cannot be considered a part of the original application papers.

The option of retaining the original filing date and entering the omitted item via preliminary amendment is not available on petition in response to a "Notice of Omitted Items." The mailing of a "Notice of Omitted Items" permits the applicant to either: (1) promptly establish prior receipt in the PTO of the drawing(s) at issue (generally by way of a date-stamped postcard receipt (MPEP 503)), or (2) promptly submit the omitted drawing(s) in a nonprovisional application and accept the date of such submission as the application filing date. An applicant asserting that the missing drawings were in fact deposited in the PTO with the application papers must file a petition (and the appropriate petition fee) with evidence of such deposit. An applicant desiring to submit the omitted drawings in a nonprovisional application and accept the date of such submission as the application filing date must file any omitted drawing(s) with an oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such drawing(s) and a petition under 37 CFR 1.182 (with the petition fee under 37 CFR 1.17(h)) requesting the later filing date within two months of the date of the "Notice of Omitted Items" (37 CFR 1.181(f)).

In this case, petitioner does not assert that the missing drawing figure was deposited on October 22, 2003, or request a April 1, 2004 filing date (the date the drawing figure was supplied). Instead, applicants seek to amend the application to include the drawing figure. However, no petition under 37 CFR 1.182 is necessary for that purpose. New drawings may be entered by the primary examiner without petition so long as the new drawings contain no new matter. See MPEP § 608.02(a).

Accordingly, to the extent the petition requests entry of the drawing figure, the petition is inappropriate and is subject to dismissal.

CONCLUSION

To the extent that the petition requests that the application be accorded a filing date of October 22, 2003 with Figure 1 as part of the original application disclosure, the petition under §1.53 is DISMISSED. However, to the extent that the petition requests that the application as originally filed, without Figure 1, be accorded a filing date of October 22, 2003, the petition pursuant to §1.53 is GRANTED.

The Office of Initial Patent Examination (OIPE) has been advised of this decision. Pursuant to this decision, the application has been referred to OIPE for further processing with a filing date of October 22, 2003 and for indication in Office records, as appropriate, that "0" sheets of drawings were present on filing.

Telephone inquiries specific to this decision may be directed to
the undersigned at (703) 305-0309.



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